

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:)	
)	
LAVERICK, DAVID J.)	Attorney Docket No.:
)	702.276
Serial No.: 10/663,045)	
)	
Filed: September 13, 2003)	Group Art Unit No. 3663
)	
NAVIGATIONAL DEVICE FOR MOUNTING)	
ON A SUPPORT PILLAR OF A VEHICLE)	Examiner: DIACOU, Ari M.
AND METHOD FOR DOING SAME)	

APPEAL BRIEF

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APPELLANTS' BRIEF ON APPEAL

In response to the Advisory Action dated November 13, 2008, and the final Office Action dated July 3, 2008, Appellants' Brief on Appeal in accordance with 37 C.F.R. § 41.37 is hereby submitted. The Examiner's rejections of claims 1-3, 5, 7, 23-26, and 29-30 are herein appealed, and allowance of said claims is respectfully requested.

No fee for this Brief and the accompanying Notice of Appeal is required as prosecution was reopened by the Examiner in response to Appellants' previous October 31, 2007, Appeal. However, the Commissioner is hereby authorized to charge any fee for this Appeal Brief, and any additional fees which may be required, or credit any overpayment, to Account No. 501-791.

Respectfully submitted,

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Appeal of U.S. Application No. 10/663,045
December 12, 2008, Appeal Brief

Following are the requisite statements under 37 C.F.R. § 41.37:

I. Real Party in Interest

David J. Laverick and Brian G. Schoenfish are the inventors of the claimed invention. The inventors assigned the above-referenced application to Garmin Ltd., the Real Party in Interest.

II. Related Appeals and Interferences

U.S. Patent Application entitled “NAVIGATIONAL DEVICE FOR INSTALLATION IN A VEHICLE AND A METHOD OF DOING SAME”, Serial No. 11/051,879, filed February 5, 2005, is related to the instant application and was the subject of a July 25, 2008, BPAI decision (Appeal No. 2008-1526).

III. Status of Claims

Claims 1-3, 5, 7, 23-26, and 29-30 stand rejected and appealed. Claims 4, 6, 8-22, and 27-28 were previously canceled.

IV. Status of Amendments

All amendments submitted by the Appellants have been entered.

V. Summary of Claimed Subject Matter

Claim 1 is directed at a navigation assembly (FIG. 22) for use in a vehicle not originally equipped with navigational capabilities. The navigation assembly comprises a portable navigational device (10k; FIG. 22; pg. 4, lines 7-14) and a mounting assembly (194k; FIG. 22, page 24, line 32, through page 25, line 9) for mounting within the vehicle and sized and configured to removably receive the navigational device. The navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly. The mounting assembly includes a trim piece (196k, FIG. 22, page 24, line 32, through page 25, line 9), a base (198k; FIG. 22, page 24, line 32, through page 25, line 9) secured to the trim, a docking station (200k; FIG. 22, page 25, lines 10-25) mounted within the base for removably docking with the navigation device, wherein the docking station is operable to electrically couple (180k, FIG. 22, page 25, lines 1-9) with the navigation device and includes a speaker (57k; FIG. 22, page 25, lines 18-25) for providing audible navigation instructions generated by the navigation device, and a retractable face plate (202k; FIG. 22; pg. 25, line 26, through pg. 26, line 4) mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station.

Claim 24 is directed at a navigation assembly (FIG. 22) for use in a vehicle not originally equipped with navigational capabilities. The navigation assembly comprises a stand-alone hand-held portable navigational device (10k; FIG. 22; pg. 4, lines 7-14) and a mounting assembly (194k; FIG. 22, page 24, line 32, through page 25, line 9) for mounting within the vehicle and operable to removably receive the navigational device, such that the navigation device remains visible and fully functional when received within the mounting assembly. The mounting assembly includes a docking station (200k; FIG. 22, page 25, lines 10-25) mounted within the base for removably docking with the navigation device, wherein the docking station is operable to electrically couple with the navigation device (180k, FIG. 22, page 25, lines 1-9) and includes a speaker (57k; FIG. 22, page 25, lines 18-25) for providing audible navigation instructions generated by the navigation device. The

mounting assembly also includes a retractable face plate (202k; FIG. 22; pg. 25, line 26, through pg. 26, line 4) mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station.

Appellants note that the page and paragraph numbers cited above are for reference purposes only and should not be taken as a limitation on the support for, nor scope of, the claimed subject matter. Support for the claimed subject matter may be found throughout the specification and drawings and the page and line numbers cited above merely refer to exemplary portions of the specification.

VI. Grounds of Rejection to be Reviewed on Appeal

- A. Whether claims 1-3, 5, 7, 23-26, and 29-30 were properly rejected under 35 U.S.C. § 103(a) as being obvious in view of Schoenfish (US 6,370,037), Sturt (US 2003/018411), Meyers (US 6102284), and Meade (NPL).

VII. Argument

A. Obviousness

The law places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. MPEP § 2143.03 similarly requires the “consideration” of every claim feature in an obviousness determination. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). Only if the Examiner’s burden is met does the burden shift to the Applicant to provide evidence to refute the rejection. *Id.*

When determining whether a claim is obvious, an examiner must make a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art. *In re Wada and Murphy*, Appeal 2007-3733 (BPAI January 14, 2008), citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Thus, obviousness requires a suggestion of all limitations in a claim. *Id.* An Examiner cannot establish that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, there must be some *reason* to combine the known elements in the claimed fashion. *Id.* Thus, an obviousness rejection cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006).

In presenting the reasoning to combine prior art references, the examiner may not resort to broad and conclusory statements; as such statements are not “evidence” of anything. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). This prohibition against conclusory examination is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision-making, as it is in § 103. *In re Kahn*, 441 F.3d at 988.

B. Whether claims 1-3, 5, 7, 23-26, and 29-30 were properly rejected under 35 U.S.C. § 103(a) as being obvious in view of Schoenfish (US 6,370,037), Sturt (US 2003/0184111), Meyers (US 6102284), and Meade (NPL).

The two independent claims, 1 and 24, each recite a docking station including a speaker for providing audible navigation instructions generated by a docked navigation device. At issue is whether the Examiner's combination of references provides any evidence that this claimed feature is obvious.

1. Claim 1

Independent claim 1 recites that the "the docking station is operable to electrically couple with the navigation device and includes a speaker for providing audible navigation instructions generated by the navigation device." Thus, the speaker recited in the independent claims comprises a portion of the docking station and not the navigation device. Such functionality may be desirable, for example, where the navigation device lacks a powerful speaker that can generate audible sound in a noisy automobile environment.

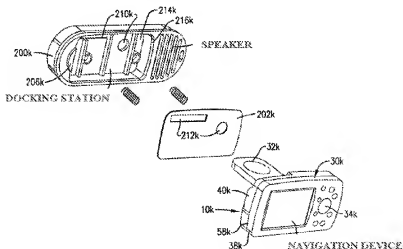


FIG. 22 (annotated)

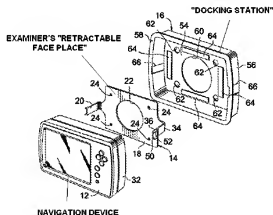
No combination of the Examiner's cited references teaches a docking station that can receive a navigation device and which includes a speaker to provide audible navigation instructions generated by the docked navigation device.

In rejecting now-canceled dependent claim 6, the Examiner asserted that Sturt discloses the claimed docking station speaker when combined with Schoenfish, Meyers, and Meade:

Regarding claim 6, Sturt discloses that 18 may be an audiovisual infotainment system [0005] and navigation systems [0033], therefore it would have been obvious to one skilled in the art (e.g. an ergonomic engineer) at the time the invention was made, to use an audible navigation device (which would be included by the docking station) for providing audible navigation instructions, for the advantage of preserving the driver's visual attention on the road.

July 31, 2008, Office Action, pg. 6

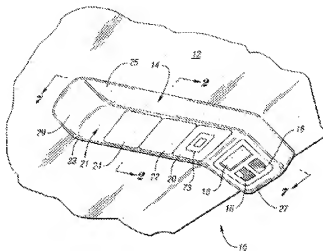
The only docking station (e.g., a mount operable to removably couple with a portable navigation device) provided in the cited references is the device disclosed by Schoenfish:



Schoenfish (FIG. 1 – annotated)

Schoenfish does not disclose or suggest that its docking station may include a speaker for providing audible navigation instructions generated by the navigation device. Thus, the Examiner relies solely on Sturt's teachings to provide evidence that incorporating a speaker into Schoenfish's docking station would be obvious to one skilled in the relevant art.

Sturt teaches an overhead console for a vehicle that can include a conventional audio/visual infotainment system:



Sturt (FIG. 1)

Specifically, Sturt teaches that the console can include a “complete audiovisual infotainment system” (§ 0005) that is permanently installed within the console to create an “aesthetically pleasing ... smoothly shaped outer structure” (§ 0033).

Notably, Sturt provides no teachings regarding speakers that provide audio for electronic components housed by the console. Sturt does not mention if the infotainment system uses an integrated speaker (e.g., a speaker housed within the console) or the vehicle’s standard car stereo speakers. Appellants assume that the Examiner conclusion is that Sturt’s infotainment system includes an integrated speaker that is the same thing as the docking station speaker recited in claim 1. A permanently-installed infotainment system having an integrated speaker is not the same thing, or even related to, a docking station having a speaker for generating audio from docked devices.

For example, if Schoenfish’s docking station was installed Sturt’s panel 24 (illustrated above), the combination still fails to provide any teachings regarding a speaker for generating audio from a device docked with Schoenfish’s docking station. Sturt, in combination with any other cited reference, does not teach an infotainment system that includes a speaker for generating audio from docked or other peripheral devices—as an integrated infotainment system does not dock with anything.

As such, the Examiner's combination of prior art references provides no evidence that modifying Schoenfish's docking station to include a speaker would be obvious to one skilled in the art.

Applying the PTO's relevant *KSR Guidelines* set forth in MPEP § 2143, claim 1 has not been properly rejected as obvious in view of the cited art:

- § 2143(a) requires a finding that the prior art combination includes *each* element claimed—which has not been made in the present examination;
- § 2143(c) requires a finding of a “comparable” device that has been improved in the *same* way as the claimed invention—which has not been made in the present examination;
- § 2143(d) requires a finding that a “known technique” exists that could be applied to result in the claimed invention—which has not been made in the present examination;
- § 2143(e) requires a finding that there are a finite number of *identified*, predictable solutions that could be chosen to result in the claimed invention—which has not been made in the present examination; and
- § 2143(f) requires a finding that the differences between the claimed invention and the prior art were encompassed in known variations of the prior art—which has not been made in the present examination.

2. Claim 24

Independent claim 24 also recites a docking station including a speaker for providing audible navigation instructions generated by a docked navigation device. For the reasons set forth above regarding independent claim 1, claim 24 is also non-obvious over the prior art of record.

VIII. Conclusion

The Examiner failed, with regard to the rejection of the pending claims under 35 U.S.C. §103(a), to establish the requisite prima facie case of obviousness because the cited prior art fails to teach each and every claim limitation—specifically a docking station including a speaker for providing audible navigation instructions generated by a docked navigation device.

Accordingly, reversal of the Examiner's rejections is proper, and such favorable action is solicited.

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VIII. Claims Appendix

1. A navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:

a portable navigational device; and

a mounting assembly for mounting within the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly,

the mounting assembly including-

a trim piece,

a base secured to the trim,

a docking station mounted within the base for removably docking with the navigation device, wherein the docking station is operable to electrically couple with the navigation device and includes a speaker for providing audible navigation instructions generated by the navigation device, and

a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station.

2. The navigation assembly as claimed in claim 1, wherein the navigational device is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle.

3. The navigation assembly as claimed in claim 2, wherein the mounting assembly is adapted for mounting on a support pillar directly above the vehicle's windshield.

4. (Canceled)

5. The navigation assembly as claimed in claim 1, the mounting assembly further including electrical connections for connecting the navigational device to a power source and a data source supplied by the vehicle.

6. (Canceled)

7. The navigation assembly as claimed in claim 6, wherein the navigational device is a global positioning satellite device including -

- a navigation component,
- a processor coupled with the navigation component,
- a memory coupled with the processor,
- a display,
- an input, and
- a housing for housing the navigation component, the processor, and the memory.

8-22. (Canceled)

23. The navigation assembly as claimed in claim 1, wherein the support pillar runs along and directly above the vehicle's windshield.

24. A navigation assembly for use in a vehicle not originally equipped with navigational capabilities, the navigation assembly comprising:

a stand-alone hand-held portable navigational device; and

a mounting assembly for mounting within the vehicle and operable to removably receive the navigational device, such that the navigation device remains visible and fully functional when received within the mounting assembly,

the mounting assembly including-

a docking station mounted within the base for removably docking with the navigation device, wherein the docking station is operable to electrically couple with the navigation device and includes a speaker for providing audible navigation instructions generated by the navigation device, and

a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station.

25. The navigation assembly as claimed in claim 24, wherein the navigational device is designed to be used independently of the vehicle rather than being particularly sized and configured to fit an existing space within the vehicle.

26. The navigation assembly as claimed in claim 24, wherein the mounting assembly is operable for mounting to a support pillar directly above the vehicle's windshield and which runs along the vehicle's windshield.

27-28. (Canceled)

29. The navigation assembly as claimed in claim 24, wherein the mounting assembly includes electrical connections for connecting the navigational device to a power source and a data source supplied by the vehicle.

30. The navigation assembly as claimed in claim 24, wherein the navigational device is a global positioning satellite device including -
a navigation component,
a processor coupled with the navigation component,
a memory coupled with the processor,
a display,
an input, and
a housing for housing the navigation component, the processor, and the memory.

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IX. Evidence Appendix

None.

X. Related Proceedings Appendix

U.S. Patent Application entitled “NAVIGATIONAL DEVICE FOR INSTALLATION IN A VEHICLE AND A METHOD OF DOING SAME”, Serial No. 11/051,879, filed February 5, 2005, is related to the instant application and was the subject of a July 25, 2008, BPAI decision (Appeal No. 2008-1526).

A copy of the BPAI decision in Appeal No. 2008-1526 is included within this Appendix.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6
7

8 *Ex parte* DAVID J. LAVERICK and BRIAN G. SCHOENFISH
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11 Appeal 2008-1526
12 Application 11/051,879
13 Technology Center 3600
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16 Decided: July 23, 2008
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19 *Before* WILLIAM F. PATE, III, HUBERT C. LORIN and
20 MICHAEL W. O'NEILL, *Administrative Patent Judges*.

21
22 PATE, III, *Administrative Patent Judge*.
23

24 DECISION ON APPEAL

25
26 STATEMENT OF CASE

27 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 1, 21 and 23-39. Claims 2 and 22 have been previously
29 canceled while claims 3-20 have been withdrawn from consideration. We
30 have jurisdiction under 35 U.S.C. § 6(b) (2002).

1 The Appellants claim a navigational device with a housing that is
2 sized and configured to substantially fit within an empty recess of a vehicle.

3 Independent claim 1 reads as follows:

- 4 1. A navigational device comprising:
5 a global positioning satellite receiver;
6 a processor coupled with the receiver for calculating a
7 location of the navigational device;
8 a memory coupled with the processor for storing
9 cartographic data; and
10 a housing for housing the receiver, the processor, and the
11 memory, wherein the housing is sized and configured to
12 substantially fit within an empty recess of a vehicle, wherein
13 the empty recess was intentionally left empty by a manufacturer
14 of the vehicle.

15
16 Independent claims 28 and 33 are directed to similar navigational
17 devices including a housing sized and configured to substantially fit within
18 an empty recess of a vehicle where the empty recess is intentionally left
19 empty by a manufacturer of the vehicle.

20 The prior art relied upon by the Examiner in rejecting the claims is:

21 Funk US 2003/0208314 A1 Nov. 6, 2003

22
23 The Examiner rejected all of the claims 1, 21 and 23-39 under 35
24 U.S.C. § 102(e) as lacking novelty over Funk.

25 We AFFIRM.

ISSUE

The sole issue raised in the present appeal is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 21 and 23-39 as lacking novelty over Funk.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Funk describes a navigational device 40 including a global positioning satellite receiver 42, a processor coupled with the receiver for calculating a location of the navigational device (not shown), a memory coupled with the processor for storing cartographic data (not shown), and a housing for housing the receiver, the processor, and the memory (Fig. 4; ¶ [0017]).

2. Funk also describes that the housing is sized and configured to substantially fit within an empty recess 48 of a vehicle (not shown) (Fig. 4; ¶ [0018]).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope

1 of the claim. We determine the scope of the claims in patent applications
2 not solely on the basis of the claim language, but upon giving claims their
3 broadest reasonable construction in light of the specification as it would be
4 interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.*
5 *Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim
6 must then be compared with the prior art.

8 ANALYSIS

9 The Examiner rejected all of the pending claims as lacking novelty
10 over Funk (Ans. 4 and 5). The Appellants disagree and argue these claims
11 together as a group in the Appeal Brief. Thus, we select representative claim
12 1 to decide this appeal, all of the pending claims standing or falling with
13 claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

14 The Appellants argue that the Examiner failed to establish a *prima*
15 *facie* case of anticipation because the recess disclosed in Funk is provided by
16 the manufacturer of the vehicle navigation system, and thus, Funk does not
17 describe “wherein the empty recess was intentionally left empty by a
18 manufacturer of the vehicle” as recited in claim 1 (App. Br. 5 and 7; Reply
19 Br. 3). The Appellants also contend that the Specification defines the recited
20 empty recess as being formed during the manufacture of a vehicle and that
21 the empty recess is provided for holding objects like glasses, CDs, CD
22 players, a garage door opener or other articles (Reply Br. 3). Thus, the
23 Appellants contend that because Funk fails to describe such a recess, Funk
24 also fails to describe a housing that is sized and configured to substantially

1 fit within such a recess (Reply Br. 3). We disagree with the Appellants'
2 analysis.

3 Initially, we find the recitations “empty recess” and “wherein the
4 empty recess was intentionally left empty by a manufacturer of the vehicle”
5 to be merely statements of intended use that do not further define the
6 claimed invention. In this regard, claim 1 is directed to a navigational
7 device. As noted by the Examiner, the structural limitations of the
8 navigational device itself as recited in claim 1 are described in the
9 navigational device of Funk (Ans. 4-6; FF 1). The recitations relied upon by
10 the Appellants for arguing patentability of claim 1 are merely directed to a
11 space in which the claimed navigational device is intended to be used. *See*
12 *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“[r]ecitation of a new
13 intended use for an old product does not make a claim to that old product
14 patentable”).

15 Furthermore, the alleged critical limitation (that “the empty recess was
16 intentionally left empty by a manufacturer of the vehicle”) is merely directed
17 to who provided the empty recess and does not relate to the claimed
18 navigational device. We find that the identity of who provided the recess for
19 receiving a navigational device to be immaterial to the patentability of the
20 claimed navigational device.

21 The Appellants’ argument that Funk does not describe an empty
22 recess as defined by the Specification also does not persuade because
23 “empty recess” is merely a statement of intended use as discussed *supra*.
24 Furthermore, while the noted portions of the Specification describe the

1 recited empty recess as having been formed during the manufacture of the
2 vehicle for holding various types of objects, the Specification does not set
3 forth a definition of an “empty recess” with sufficient clarity so as to provide
4 a clear and precise notice of the asserted meaning which disclaims the
5 broader definition of an empty recess. *See In re Paulsen*, 30 F.3d 1475,
6 1480 (Fed. Cir. 1994); *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004).

7 Finally, to any extent that the recited housing of the navigational
8 device is defined by an empty recess, Funk likewise describes such a
9 housing that is defined by recess 48 (Ans. 4 and 6; FF 2).

10 In view of the above, we find that the Appellants have not shown that
11 the Examiner erred in rejecting claim 1 as lacking novelty over Funk. Thus,
12 we likewise find that the Appellants have not shown that the Examiner erred
13 in rejecting claims 21 and 23-39 as lacking novelty over Funk.

14
15 CONCLUSION

16 The Appellants have not shown that the Examiner erred in rejecting
17 claims 1, 21 and 23-39.

18
19 ORDER

20 The Examiner’s rejection of claims 1, 21 and 23-29 is AFFIRMED.

21 No time period for taking any subsequent action in connection with
22 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
23 § 1.136(a)(1)(iv) (2007).

AFFIRMED

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